

REMARKS

This application is believed to be in condition for allowance for the reasons stated in this response.

Status of the Claims

Claims 13, 15-26, 32, and 33 remain pending.

Claim Rejections-35 USC §102

Claims 13, 15-18, 21, 24, 25, 32 and 33 stand rejected under 35 U.S.C. §102(b) as anticipated by GODA U.S. 3,741,444 (GODA). The rejection is respectfully traversed for the reasons stated below.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In the instant case, GODA does not teach "each and every element" of independent claims 13, 32 and 33, as discussed in detail below.

Claim 13 (and dependent claims 15, 18 and 21-25)

GODA fails to teach at least three features of claim 13:

1. A passage in an actuating member.

Claim 13 requires a "passage [through which liquid or semi-liquid product is ejected] in said actuating member".

The Official Action maintained that the syringe (40) of GODA is an "actuating member".

However, the Official Action has not provided any basis for asserting that the syringe (40) as a whole inherently meets the characteristics of an "actuating member", i.e., as described by the present specification and as known by one skilled in the art.

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In the instant case, the teachings of the applied prior art with respect to the characteristics of the syringe (40), as a whole, are not those of an "actuating member".

Indeed, while it recognized that the USPTO is to give "the broadest reasonable interpretation of the claims", this is "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004).

The specification clearly sets forth that the term "actuating member" concerns exclusively the part(s) which is (are) actuated (e.g., by hand) and movable in an actuating

direction. See, e.g., page 1, lines 4-13 of the present specification. This meaning is consistent with "actuating" as understood by one skilled in the art.

Accordingly, a "passage in said actuating member", as recited in claim 13, is a passage forming these parts that are actuated by hand and movable. As described in the application the passage is located in the push button (22) of the present invention.

When "actuating member" is viewed in light of the specification and the conventional meaning of "actuating", it would have been readily apparent to one skilled in the art that the entire syringe (40) not an actuating member, i.e., the entire syringe (40) does not "actuate" or move, but rather the syringe (40) comprises an actuating member.

That is, GODA discloses a bottle, or dispensing device, including a bottle (10), an ejection assembly (20, 40, 50) that is supported on a wall (33) of the bottle and that is equipped with syringe (40) emerging from a centrally located opening on top of said bottle. The syringe (40) comprises a plunger (44), piston (43) and barrel (41). The plunger (44) is actuated by hand, which moves the piston (43) in the barrel (41). (See column 2, line 46-47 of GODA).

Consequently, in GODA, the actuating member concerns exclusively the movable parts (44) and (43), not the syringe (40) *per se* as alleged in the Official Action.

No other part of the syringe (40) could be interpreted as an actuating member. Particularly, the barrel (41), in which the piston (43) is slidable, is not a part of the actuating member, because the barrel (41) does not move when the plunger (44) and piston (43) are actuated or moved by hand.

Instead, the barrel (41) of the syringe (40) communicates with a communicating reservoir (51) which communicates with a valve (80) which itself communicates with a tube (61) plunging into the bottle (10) and which also communicates with a flexible horizontal output tube (60).

To allow the liquid to flow out of the bottle, the plunger (44) must first be raised, which simultaneously raises the piston (43), moving upward in the barrel (41), to suck the liquid through the valve (80), and the plunger (44) must then be depressed to close the valve (80) and to push the liquid into the horizontal output tube (60).

As it can be clearly seen, in GODA, the actuating member, which consists of the plunger (44) and piston (43) in combination, does not have any passage in said actuating member.

The passage of GODA which communicates with the tube (60) is formed in the section (50), below the actuating member (44), and is not located through the actuating member.

As a consequence, the passage of GODA relative to the plunger (44) and piston (43) does not anticipate the feature of claim 13, in which the passage is in the actuating member.

For this reason, GODA fails to anticipate claim 13.

2. An outlet member fixedly connected to a reservoir.

Claim 13 requires an outlet member being connected fixedly to a reservoir and comprising an outlet opening to dispense said quantity of product.

The rejection, however, appears to be based on a modification of the teachings of GODA, i.e., based on obviousness, rather than anticipation.

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' "In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

In the instant case, GODA does not make it clear that the outlet member is connected "fixedly" to a reservoir, but rather the Official Action suggests that such a configuration is probable or possible.

GODA comprises a connecting member (60, 70, 75, 81) comprising:

- a first end connected to the section (50) in the horizontal direction,
- a second end (81) connected to a valve (81) connected to a short piece of output tubing (82),
- a flexible output tube (60) extending between said first and second ends and that is adapted to conduct said quantity of the liquid or semi-liquid product to said outlet member without transmitting any substantial force to said outlet, the tube being adapted to extend out of said bottle through the exit aperture of a cap member (33) (See claim 1 c, line 17-19 of GODA)
- an elongated post member (70) rigidly mounted in said cap (33) adjacent said plunger and extending upwardly from said cap (see claim 1.e. line 23-25)
- said output tube (60) extending out of said bottle through said tubular post member (see claim 3, line 37-38),
- an extra tubing length is contained within said bottle (see claim 5, line 42-44).

As now agreed in the Official Action, the tube (60) has a first end connected to section (45), and a second end linked at (81) to output tubing (82).

The description of GODA also specifies (col 1, line 66-col 2 line 2) that *"the outlet tube which is preferably a*

flexible plastic tube is adapted to extend out of the bottle through the exit aperture of the cap member". As specified in the text, (col 4 lines 2-4): "The passage in the post (70) has sufficient clearance for the tubing to pass freely".

The tubing (60) passes freely through a passage in post (70), and is linked further to the valve 81 and tubing 82. Element 70 is only a guide for the tube (60, 70, 75). In addition, since the description explains col 3, line 61 - col 4, line 5, *"the tubing can readily be pulled from, or pushed into, the bottle to suit convenience"*, this also shows that the outlet member is free when in use.

Because (81) is adjustable by the user orientation of arm (99) to a position that does not extend in the same vertical flat plane as a line directly connecting the actuating member and the outlet member, the Official Action considers that GODA anticipates claim 13.

However, this would be true only if the outlet member 81, 82 could satisfy integrally with the drafting of claim 13, i.e. only if the outlet member 81, 82 would be rigidly connected to the reservoir.

But, as it has been explained before, the outlet member (81, 82) disclosed in GODA is free when in use, and, most of the time, can not be received in the arm (99). So the position in which *it does not extend in the same vertical flat plane as line directly connecting the actuating member and the*

outlet member is not a long lasting position, but a temporary position.

Applicant respectfully requests that the Examiner identify where in GODA one may find a description or passage showing that the outlet member can be used in this rest position. The Examiner should use the text - and only the text - of the cited patent, where the arm (99) is defined as a REST ARM (99). This text excludes any other use of the nozzle (81, 82) when received in the arm.

Thus, the interpretation of the rest arm made in the Official Action is not to be based on inherency, but instead, based on the modification of the teachings of GODA, i.e., based on obviousness, using *impermissible hindsight* with the knowledge of the claimed invention.

As a consequence, outlet member (81, 82) is not fixedly connected to said bottle, but is removably linked to the bottle.

For this second reason, GODA does not anticipate claim 13.

3. A connecting member as claimed.

Moreover, since the outlet member (81, 82) can be removed from the rest arm, its direction can change in many ways. Thus, the direction in which the outlet member extends can also change, depending on the use of the outlet member, can not be defined.

Consequently, no one can exactly define a vertical flat band containing a geometric line directly connecting the axis of actuating member (44) and said outlet member (81, 82).

As a consequence the outlet member (81, 82) does not anticipate the written features of claim 13, in which *"the first end of the connecting member extends in a direction different from a direction in which the second end of the connecting member (directly linked to element 81, 82) connected to the outlet member extends, and at least one of the first and second ends, does not extend in the same direction of a vertical flat band connecting said actuating member and said outlet member"*.

For this third reason, GODA does not anticipate claim 13.

Therefore, claim 13, and dependent claims 15-18 and 21-25 are not anticipated, and withdraw of the rejection is respectfully requested.

Claims 32 and 33

1. A horizontally arranged nozzle of claim 32.

The device disclosed in the present application and claimed at claim 32 differs from the device disclosed by GODA in that GODA does not disclose a horizontally arranged nozzle, and in that the nozzle is not fixed to the device.

GODA does not disclose any horizontally arranged nozzle, because, as it has been explained above (with respect to reason 2 relative to claim 13), the outlet tube (82) of GODA can be free (for example, when in use), so that no direction, horizontal or not, can clearly be determined.

Moreover, in GODA, since the outlet member or nozzle (81, 82) can be removed from the rest arm, its direction can change in many ways. Accordingly, the nozzle (81, 82) is not fixed to the device because it is not always fixed, but only in rest position.

Indeed, as noted above relative to claim 13 (reason 2), the interpretation of the outlet member (81, 82) appears to more appropriate for an obviousness rejection, albeit one based on impermissible hindsight.

As a consequence, the outlet member (81, 82) does not anticipate the features of claim 32.

For this reason GODA does not anticipate claim 32.

2. A horizontally arranged nozzle of claim 33.

The device disclosed in the application and claimed at claim 33 differs from the device disclosed by GODA in that GODA does not disclose any horizontally arranged nozzle, because, as it has been explained above, the outlet tube (82) of GODA can be free (for example, when in use), so that no direction, horizontal or not, can be clearly identified.

Moreover, in GODA, since the outlet member or nozzle (81, 82) can be removed from the rest arm, its direction can change in many ways.

So GODA fails to disclose a nozzle (81, 82) which is fixed to the device.

Furthermore, the direction, i.e., in which the outlet member extends, can also change, depending on the use of the outlet member, and is not defined. Consequently, no one can exactly define a vertical flat plane containing a geometric line directly connecting the pump to the nozzle.

For this reason, GODA does not anticipate claim 33.

Therefore, claims 32 and 33 are not anticipated by GODA, and withdrawal of the rejection is respectfully requested.

Claim Rejections-35 USC §103

Claims 19, 20 and 26 stand rejected under 35 U.S.C. § 103(a) as obvious over GODA in view of LEE U.S. 2003/0160070. This rejection is respectfully traversed for the reasons that follow.

Claims 19 depends on claim 13, which is not anticipated by GODA.

Claim 20 depends on claim 19, and claim 26 depends on claim 20. Finally, all these claims depend on claim 19 which depends itself on claim 13.

LEE discloses conventional liquid containers, the reservoirs (2) of which can be of different shapes, in particularly non-circular in horizontal section.

But in LEE, the dispensing nozzles are slidably movable with the ejection assembly, so that it can not be found in LEE any outlet member rigidly fixed to the reservoir.

As a result, LEE fails to disclose an outlet member rigidly fixed to the reservoir.

As it has been explained above, GODA also fails to disclose an outlet member rigidly fixed to the reservoir.

As a result, the combination of GODA and LEE discloses a reservoir non-circular in horizontal section, but does not disclose any outlet member being connected fixedly to said reservoir (2).

Consequently, none of claim 19, 20 and 26 is rendered obvious by the combination of GODA and LEE.

Therefore, withdrawal of the rejection is respectfully requested.

Claims 13, 15-23, 25, 26, 32 and 33 were rejected under 35 U.S.C. § 103(a) as obvious over CAMPBELL in view of GODA. This rejection is respectfully traversed for the reasons that follow.

Claims 13, 15-23, 25 and 26

As discussed above relative to the anticipation rejection, GODA fails to disclose the features of claims 13, 15-23, 25 and 26.

CAMPBELL discloses a farm bucket comprising a bottle (38), or dispensing device, including a reservoir, an ejection assembly (104, 105, 106) that is supported on a wall (40) of the reservoir and that is equipped with an actuating member (60) emerging from a centrally located opening (100) on top of said reservoir.

However, the combination fails to teach at least two features of claim 13 as discussed below:

1. A passage in an actuating member.

The Official Action asserts that pumping means (44) of CAMPBELL is an "actuating member".

However, similar to the anticipation rejection based on GODA (as discussed above with respect to reason 1), the Official Action asserts that pumping means (44) inherently meets the characteristics of an "actuating member", but fails to provide a factual or technical basis in light of the teachings of CAMPBELL.

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the

teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In the instant case, the pumping means (44) of CAMPBELL does not have the characteristics of an "actuating member".

While it acknowledged that the USPTO is to give "the broadest reasonable interpretation of the claims", this is "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004).

The specification clearly sets forth that the term "actuating member" concerns exclusively the part(s) which is (are) actuated (e.g., by hand) and movable in an actuating direction. See, e.g., page 1, lines 4-13 of the present specification. This meaning is consistent with "actuating" as understood by one skilled in the art.

In CAMPBELL, the feature that has the characteristics of an "actuating member" includes a rod (60, 66 68, 70), which is slidably movable within a sleeve (46) of the pumping means (44). This rod (60, 66 68, 70) is manually movable by the lever (12) in a vertical actuating direction in order to eject a quantity of liquid or semi-liquid product from the reservoir 10 through a passage in the sleeve (46) surrounding the rod (60), or actuating member. See, e.g., column 3, lines 20-50.

As also discussed above relative to the anticipation rejection and reason 1, only the movable parts can be considered part of the actuating member. That is, neither the sleeve (46) nor the pumping means (44) viewed as a whole actuates or moves.

Thus, the teaching of CAMPBELL is not that the pumping means (44) is an "actuating member", but rather the pumping means (44) comprises an "actuating member".

The passage is linked to an outlet ball valve (105) of an outlet member (107) which is connected perpendicularly to the passage.

CAMPBELL also comprises a connecting member (14) comprising a first end connected to the valve (85) in a horizontal direction, and a second end connected to an outlet member (24) which can mate with the device (26) to be greased.

As it can be seen, CAMPELL fails to disclose any passage in said actuating member (a first part of the passage surrounds the actuating member in the sleeve (46), then a second part of the passage in the valve 105, 107 is connected perpendicularly to the first part of the passage.)

As explained before with respect to the anticipation rejection, GODA also fails to disclose either the actuation member.

For this reason, claim 13 (and dependent claims 15-23, 25 and 26) cannot be rendered obvious by the proposed combination.

2. An outlet member fixedly connected to a reservoir.

CAMPBELL also fails to disclose any rigidly fixed outlet member, i.e., because the outlet member must be free to mate with different devices to be greased.

As explained before with respect to the anticipation rejection, GODA also fails to disclose a fixed outlet member.

Thus, not only does the combination fail teach this claimed feature, but to even approach the claimed invention would have rendered the outlet member of CAMPBELL unsatisfactory for its intended purpose.

As explained before with respect to the anticipation rejection, GODA also fails to disclose either the actuation member or the fixed outlet member.

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

For this second reason, the combination fails to render obvious claim 13, or claims 15-23, 25, 26.

Therefore, the combination of GODA and CAMPBELL does render obvious the features of claim 13, or claims 15-23, 25, 26, and withdrawal of the rejection is respectfully requested.

Claims 32 and 33

Neither GODA nor CAMPBELL discloses a nozzle rigidly fixed to the device as recited in claims 32 and 33.

Consequently, the combination of GODA and CAMPBELL does not disclose a nozzle rigidly fixed to the device.

There the combination of GODA and CAMPBELL does not render obvious claims 32 and 33, and withdrawal of the rejection is respectfully requested.

Conclusion

In view of the foregoing remarks, it is respectfully submitted that the present application is in condition for allowance and early notice to that effect is hereby requested.

Should the Examiner have any comments or proposals for expedited prosecution, please contact the undersigned attorney at the telephone number below.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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